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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/972,653	11/18/97	PUTERKA	G 4030C

IM12/0723

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EXAMINER	
LOVERING, R	

ART UNIT	PAPER NUMBER
1721	6

DATE MAILED: 07/23/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
08/972,653	PUTERKA ET AL.
Examiner	**Group Art Unit**
LOVERING	1721

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on NOV. 18, 1997 AND FEB. 9 & JUN. 1, 1998.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-9 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-9 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____.

Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

☐ Interview Summary, PTO-413

☒ Notice of References Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Action Summary

1.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2.

Claims 1, 3 and 9 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Marotta 3,159,536, especially Table I; and Examples I-III.

3.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4.

Claims 2, 4-6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marotta above.

The especially pertinent portions of Marotta are pointed out in paragraph 2 above. As to clams 2 and 6 herein, while Marotta may not exemplify using particulate material most of which has a size under 10 microns or 3 microns, it would have been obvious to one skilled in the art at

the time applicants' invention was made to do so, since Marotta suggests this in column 7, lines 37-54. As to claims 4 and 5 herein, while Marotta may not exemplify treating cereal grains with his composition, it would have been obvious to one skilled in the art at the time applicant's invention was made to do so in view of the patentee's teaching in column 3, lines 5-7. As to claim 8 herein, while Marotta may not exemplify treating growing crops with his composition, it would have been obvious to one skilled in the art at the time applicants' invention was made to do so since the particulate material of Marotta would be expected to perform its arthropod killing and/or repelling effects wherever it is applied.

5.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marotta above in view of Jack et al, "The effect of suspended clay on ciliate population growth rate", Freshwater Biology (1993) 29, 385-394.

The especially pertinent portions of Marotta are pointed out in paragraph 2 above. While Marotta may not disclose applying his particulate material in the form of an aqueous slurry in which most of the particles are 1 μm or less, it would have been obvious to one skilled in the art at the time applicants' invention was made to do so in view of the disclosure of Jack et al (especially page 387, second full paragraph) that aqueous slurries are a known form for applying particulate material for inhibiting the growth rate of undesired species..

6.

Claims 4 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 7 recites the broad recitation "applying to the surface...applying to the surface, and the claim also recites "applying to the surface...an effective amount of a slurry... which is the narrower statement of the range/limitation. Claim 4 recites a Markush group which is not considered proper for the reason that it is indefinite as to scope and incomplete as to its membership in not reciting --the group consisting of-- after "from".

7.

The disclosure is objected to because of the following informalities: In the specification: page 2, line 13," `945" should be --`954--; and page 10, lines 9 and 10 the Serial No. And filing date of the copending case should be inserted.

Appropriate correction is required.

8.

The remaining references listed on the attached form PTO 1449 (6 pages) and form PTO `892 are cumulative to the references applied herein, and/or further show the state of the art.

9.

Any inquiry concerning this communication should be directed to Examiner Lovering at telephone number (703) 308-0443.

Lovering:jp

July 21, 1998

Richard D. Lovering
RICHARD D. LOVERING
PRIMARY EXAMINER
GROUP ~~1200~~ 1700